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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,108	01/25/2002	Geert Plactinck	D00590.70011.US	1549

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EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,108

Applicant(s)

PLAETINCK ET AL.

Examiner

Joseph T. Voitach

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This application filed January 25, 2002, is a divisional of 09/347,311, filed July 2, 1999.

Applicants amendment filed October 26, 2004 has been received and entered. The specification has been amended. The abstract has been amended. Claims 42-53 have been canceled. Claims 1-41 are pending.

Election/Restrictions

As indicated previously Groups I-III were rejoined.

Claim 1-41 are currently under examination as they are drawn to a micro-organism comprising an expression vector that when expressed produces double stranded RNA and to use of said product in a method for reducing the expression of a gene of interest in *C. elegans*.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

The objection to the specification is withdrawn.

Art Unit: 1632

The amendments to the specification have addressed the objection to the specification and the sequence compliance requirements.

Abstract

The objection to the abstract is withdrawn.

The newly submitted abstract has obviated the objection.

Oath/Declaration

The newly filed declaration is in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required.

Information Disclosure Statement

The request to consider the IDS filed because the references are available in related applications is noted. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Great Britain on July 3, 1998. It is noted, however, that applicant has not filed a certified copy of the GB 9814536.0 application as required by 35 U.S.C. 119(b).

In addition, it is noted that the foreign priority claim filed on October 6, 2004 was not entered because the foreign priority claim was not filed during the time period set forth in 37

Art Unit: 1632

CFR 1.55(a)(1). For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f) or 365(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim (37 CFR 1.55(c)). The petition must be accompanied by (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d) and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1632

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-41 stand rejected under 35 U.S.C. 102(a) as being anticipated by Timmons *et al.* (Nature 395:854, (October 1998)).

Applicants argue that Timmons *et al.* should not be considered prior art because the effective filing date of the instant application is prior to the publication date of Timmons *et al.* Applicants' arguments have been fully considered, but not found persuasive.

Applicants priority claim is noted, however it has not been perfected because the certified copy of the foreign application is not present in the application.

As stated in the previous office action, claims 1-41 encompass a micro-organism comprising an expression vector that when expressed produces double stranded RNA and to use of said product in a method for reducing the expression of a gene of interest in *C. elegans*. Dependent claims set forth the use of specific promoters and genes of interest to be expressed. Timmons *et al.* report that genetic interference can be practiced in *C. elegans* and that the dsRNA can be introduced into *C. elegans* by providing the RNA in its food source. Further, the RNA can be generated by the food source through the expression of heterologous polynucleotide sequence using a promoter specific for the food source such as the T7 sequence. Timmons *et al.* teach that the bacteria expressing the dsRNA can be used to express any gene of interest and provided to *C. elegans* as a food source wherein the expression of the dsRNA results in the down regulation of the gene of interest in the *C. elegans*.

Applicants do not contest the teachings of Timmons *et al.*, only that should not be considered prior art because of the effective filing date of the instant application. Therefore, for the reasons above the rejection is maintained.

Claims 1-41 stand rejected under 35 U.S.C. 102(e) as being anticipated by Fire *et al.*(US Patent 6,506,559 B1).

Applicants do not address the rejection made over Fire *et al.*(US Patent 6,506,559 B1). Therefore, the rejection is maintained for the reasons of record. Briefly, Fire *et al.* report that genetic interference can be practiced in *C. elegans* and that the dsRNA can be introduced into *C. elegans* by providing the RNA in its food source. Further, the RNA can be generated by the food source through the expression of heterologous polynucleotide sequence using a promoter specific for the food source such as the T7 sequence. Fire *et al.* teach that the bacteria expressing the dsRNA can be used to express any gene of interest and provided to *C. elegans* as a food source wherein the expression of the dsRNA results in the down regulation of the gene of interest in the *C. elegans*.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 1632

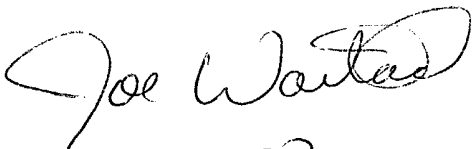
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach


AU1632